

REMARKS

Claims 21-50 were pending in this application prior to this amendment, with claims 21-35 having been withdrawn from consideration. By this amendment, claims 21-35 and 44-50 are canceled.

Claim 36 is amended to recite a structural feature, as supported in the specification in FIGS. 10 and 11, and paragraphs [0039] and [0040]. Claim 39 is amended to recite an alternate temperature limitation, as supported in the specification in paragraphs [0042] and [0043]. Claims 40-42 are amended to better conform with the language used in claim 36 from which they depend. Claim 43 is amended to specify some of the metals that may be used for the elastic metal. Support for this amendment can be found in the specification in paragraph [0023].

New claims 51-57 are added. Support for these new claims can be found in the specification at paragraph [0030], FIG. 4C of the drawings, and the original claims. Upon entry of these amendments, claims 36-43 and 51-57 will be pending in this application.

REJECTIONS UNDER 35 U.S.C. § 112

The Office Action contends that claims 36-50 are indefinite, and therefore, not in compliance with § 112, second paragraph. Claims 44-50 are canceled. Claim 36 is amended to delete the phrase “temperatures suitable for use on a subject’s body tissue.” Claim 38 is amended to recite a numerical value for normal body temperature, which is well-known to be about 37° C. Without conceding that the use of the term “approximately” is improper, this term is replaced with “about,” which is deemed acceptable according to MPEP § 2173.05(b). For at least these reasons, Applicant contends that claims 36-43 are in compliance with § 112, second paragraph, and Applicant requests withdrawal of this rejection.

REJECTIONS UNDER 35 U.S.C. § 102 AND § 103Claim 36

The Office Action contends that claims 36-50 are anticipated under § 102(b), or in the alternative, rendered obvious by WO 97/04895 (*Zadno-Azizi et al.*). Claims 44-50 are canceled. Claim 36 is amended to recite that the “two-way actuator has one or more finger portions for grasping body tissue.” For example, FIGS. 10 and 11 show tubular structures having finger portions that can grasp body tissue.

Zadno-Azizi fails to teach a structure having “one or more finger portions for grasping body tissue.” Furthermore, *Zadno-Azizi* fails to even recognize the problem of grasping body tissue. Thus, all of the structures in *Zadno-Azizi* (e.g., solid cylinders, sheets, wires, guidewires, or coils) are incapable of performing a grasping function -- and *Zadno-Azizi* provides no motivation or suggestion that these structures should be modified in such a way. Furthermore, the only structure described by *Zadno-Azizi* as having any medical application is a guidewire. But modifying a guidewire to grasp body tissue would render the guidewire unsatisfactory for its intended purpose (*see* MPEP § 2143.01), since guidewires are designed to be smoothly inserted into a tubular body structure without snagging any body tissue.

For at least these reasons, Applicant contends that claims 36-43 are neither anticipated nor rendered obvious by *Zadno-Azizi* and Applicant requests allowance of these claims.

New Claims 51-57

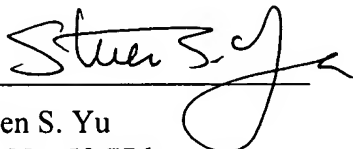
Applicant contends that new claims 51-57 are neither anticipated nor rendered obvious by *Zadno-Azizi*. Independent claim 51 requires “a plurality of discrete elements disposed within the wall of the hollow tube such that each discrete element is not in contact with another discrete element.” This feature cannot be found in *Zadno-Azizi*. Furthermore, there is no motivation or suggestion that the solid cylindrical structures of *Zadno-Azizi* should be hollow; or that they should have a “plurality of discrete elements” instead of a continuous layer of the shape memory alloy. For at least these reasons, Applicant contends that claims 51-57 are patentable over *Zadno-Azizi* and Applicant respectfully requests allowance of these claims.

CONCLUSION

Applicant respectfully submits that the present application is now in condition for allowance. The Examiner is invited to contact Applicant's representative to discuss any issue that would expedite allowance of this application. Applicant petitions for a one-month extension of time and the Commissioner is authorized to charge all required fees, fees under § 1.17, or all required extension of time fees, or to credit any overpayment to Deposit Account No. 11-0600 (Kenyon & Kenyon LLP).

Respectfully submitted,

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